

REMARKS

The Office has required restriction in the present application as follows:

Group I: Claims 1-12 drawn to an image forming method; and

Group II: Claims 13-20 drawn to a toner.

Applicants have elected, with traverse, Group II, claims 13-20 for examination in this application. Applicants note that upon indication of allowability of the subject matter of these product claims, Applicants reserve the right to rejoin claims to an image forming method using the toner of the Group II claims, so long as all limitations of the allowed product claims are present in the rejoined method claims.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness.

MPEP §803

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Office has noted that Groups II and I are related as product and process of use. Citing MPEP 806.05(h), the Action states that inventions in this relationship can be found to be patentably distinct if either (1) the process as claimed can be practiced with a materially different product or (2) the product as claimed can be used in a materially different process. The Action further states that in the present case the product as claimed can be used in another and materially different process such as forming an electrostatic image on the surface of a dielectric sheet material with an ionographic pen, developing the image with the toner, fixing the image on the surface, and applying a clear coversheet to form a permanent image. However, the Action provides no reasons or support for the assertion that the product can be

used in such a process, nor to distinguish such a process from the claimed process of Group I. Accordingly, the reasons provided are insufficient to support the conclusion of patentable distinctness.

Moreover, MPEP §803 states:

"If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

Accordingly, and for the reasons presented above, Applicants submit that the Office has not met the burden necessary in order to sustain the requirement for restriction.

Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

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